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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,832	06/21/2001	Elaine A. Delack	P0136	8018

7590 06/16/2005

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,832

Applicant(s)

DELACK, ELAINE A.

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,4 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) 1,4,19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 18,21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

I. Applicant's arguments filed 3/25/05 have been fully considered but they are not persuasive. See argument below.

Rejection of claims 18,21-23 under 35 USC 102(b) will be maintained for reason on record and reason as follows. Applicant argues that Greenberg does not teach the chronic treatment of rats with mono-oxidase A agonist (reserpine). Applicant argues that Greenberg does not teach a therapeutic treatment using reserpine. Applicant argues that Greenberg teaches against the use of reserpine (8 micromoles/kg or 4864 mg/kg) for treating aging. Examiner disagrees with Applicant. Examiner argues that Greenberg does administer reserpine to rats to study the therapeutic impact of reserpine on aging.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18,21-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating MS, does not reasonably provide enablement for treating neurodegenerative diseases broadly, effects of aging, autoimmune conditions, and fibromyalgia with instant mono-oxidase A or mono-oxidase A agonist. See Recent Adv. Pharmacol. Adrenoreceptors, Proc. Satell. Symp. Int. Congr. Pharmacol., 7th 241-50. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the

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invention commensurate in scope with these claims. The mechanism for inhibiting the various claimed said conditions and diseases differ. The predictability in this art is high since the mechanism by which claimed conditions and diseases are inhibited by the instant compounds differ. To one of ordinary skill in the art, it would be a big job to determine the mechanism of action by which the instant compounds inhibit the instant conditions and diseases since Applicant provides Examples only for how instant compounds are used to treat MS. Because of this large burden (determination of which compounds would render desired results), Examiner would like to point out that Applicant would be entitled to a subgenus of what is being claimed. Examiner stresses that the subgenus created should be a group of MS related conditions. With respect to the treatment claims, it would be a great burden on the Examiner to determine which therapies (disorders) would be treated with the compounds. The treatment claims are broad and would require a large degree of experimentation to determine which therapies are treated. There are a large number of therapies and many of them are unrelated. While specification is enabled to a small group of MS related therapies, specification is not enabled for all disorders.


Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', with a stylized flourish at the end.

Alton Pryor
Primary Examiner
AU 1616